

Atty. Docket No. JP920000032US1
(590.050)

REMARKS

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This submission is made in response to the Non-Final Office Action dated October 10, 2006. Claims 1-4, 6 and 7 are currently pending for examination, all of which are independent claims. In response Applicant has filed herewith an Amendment canceling claim 5 and amending claims 1, 4 and 7.

Applicant and the undersigned are most grateful for the time and effort accorded the instant application by the Examiner. The Examiner is respectfully requested to reconsider the rejections presented in the outstanding Office Action in light of the foregoing amendments and following remarks.

Applicant intends no change in the scope of the claims by the changes made by this amendment. It should be noted these amendments are not in acquiescence of the Office's position on allowability of the claims, but merely to expedite prosecution.

Rejections under 35 U.S.C. § 103(a):

Claims 1-7 stand rejected as being unpatentable over U.S. Patent 6,260,141 to Park (hereinafter "Park") under 35 U.S.C. § 103(a).

As best understood, Park discloses a software license control system that allows users to download and use software programs. Each user and computer is assigned a particular user public key which acts in concert with a secret key assigned by a software registration server. These two keys are contained within a user-ID file. The software registration server then uses the user public key and secret key to generate a license file

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that is transmitted to the specific CPU of a specific user by the software registration server. When a user updates a downloaded program or downloads a new program the software registration server utilizes the user public key and the secret key in the user-ID file to generate a new license file, which is then transmitted to the user's CPU (col. 3 line 12-col. 4 line 65).

Broadly, the instantly claimed invention provides a method and system for the distribution of free software by an Internet provider to and for the use of its customers during the time in which the user remains a customer of the Internet provider. However, should the user end its relationship with the Internet provider, the present invention also provides a method for ensuring that the continued use of the software by the user is no longer possible; furthermore, the presently claimed invention, also, provides a way in which the licensing information required for use of the provided software can be updated upon the connection of the user to the Internet Service Provider.

Applicant respectfully submits that in order to establish a *prima facie* case of obviousness three criteria must be met. First, must be some suggestion or motivation to modify a reference or combine reference teachings, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. Second, the modification or combination must have some reasonable expectation of success. Third, the prior reference or combined references must teach or suggest all the claim limitations. MPEP § 2143.

With regards to the rejection of claim 1, the claim, as amended, sets out the step of transmitting to the information terminal of the user, information with which a license

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key that is referred to when a downloaded program is activated or executed and that disables at least a part of the function of the program when the program matches a predetermined license condition can be generated at the user's information terminal. Applicant respectfully submits that Park does not teach such a step.

Rather Park only teaches the creation of a license file by a software registration server based upon information contained within a user-ID file that is located on a user's CPU (col. 3 line 47-col. 4 line 9). Even if the "license file" taught by Park were to somehow correspond to Applicant's claimed "license key" the teachings of Park are not sufficient to render the claimed subject matter of claim 1 as obvious since the license file of Park is not generated at the terminal of a user. Rather the license file is generated by the software registration server and then transmitted to a user's terminal (col. 3 line 47-col. 4 line 65).

Park makes specific reference to this within the specification: "When a CPU is registered, the user gets a license file from the software registration server." (col. 3 lines 55-57); "The CPU is registered to the software registration server and receives a license file that includes CPU information encrypted by the user public key and is digitally signed by software registration server secret key." (col. 4 lines 56-59); "Upon purchasing of a software product, the software product is registered to the software registration server. The user receives an updated license file which now includes the purchased software product information in addition to CPU information. This new license file replaces the old license file." (col. 4 lines 60-65).

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The Examiner also seems to imply that the teachings of Park with respect to updating the license file corresponds to Applicant's claim 1 as to the generation of a new license key at a user's terminal. Applicant respectfully disagrees. The teachings of Park on this matter are unclear at best and do not serve to render the claimed subject matter obvious. Park states: "The license file is updated every time the user purchases a new software product or upgrades a software product. The software product information is added to the license file every time a new product is purchased or a product is upgraded. Also, because of expiration date, the license file is refreshed periodically (col. 3 lines 57-62)." This language does not make clear whether this "updating" takes place at a user's CPU or involves the creation of an updated license file by the software registration server, which is then transmitted to a user's CPU.

Park perhaps sheds some light on this confusion when it states, as quoted above, that upon purchasing a new software product the user receives an updated license file that replaces the old license file. (Col. 4, lines 60-65) Applicant respectfully submits that this teaching of Park leads to only one inference: that the "updating" taught by Park is in fact the generation of an updated license file by the software registration server, which replaces an old license file. This is in stark contrast to Applicant's claimed subject matter, which requires that a new license key can be generated at a user's information terminal.

Applicant respectfully submits that Park does not teach a license key that can be generated at a user's information terminal, therefore further rejection of claim 1 on these grounds would be improper.

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With regards to the rejection of claims 2 and 3, the claims set out the steps of transmitting to the user's information terminal information from which a new license key can be generated and then generating a new license key at the user's information terminal. The Examiner implies that these steps correlate to the generation of a license file and the transmission of the license file from the software registration server to a user's CPU taught by Park. As discussed above with respect to claim 1, Park merely teaches the creation of a license file by a software registration server based upon information located within a user-ID file located on a user's CPU. The software registration server then transmits this license file to a user's CPU (col. 3 line 47-col. 4 line 65). Also, as discussed above with respect to claim 1 there is no clear teaching or reasonable inference from Park as to the transmission of information to a user's CPU of information from which a new license file can be generated and the subsequent generating of a new license key at the user's CPU file (col. 3 lines 57-62, col. 4 lines 60-65). Applicant respectfully submits that the rejection as to claims 2 and 3 is therefore improper.

With regards to the rejection of claims 4 and 7, these claims, as amended, contain the method limitation of transmitting, from said network provider to said information terminal of said user, information that can generate a new license key at the information terminal of said user. As previously discussed with respect to claim 1, Park does not teach such a limitation nor can such a limitation be reasonably inferred from Park. Applicant therefore respectfully submits that further rejection of claims 4 and 7 on these grounds would be improper.

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With regards to the rejection of claim 6, this claim contains subject matter as to program code for generating a new license key at the information terminal of said user for said downloaded program when said user is again connected to the network provider. As previously discussed with respect to claim 1, Park does not teach program code encompassing such functionality nor can such functionality be reasonably inferred from the teachings of Park. The only reasonable inference is that Park merely and indirectly teaches program code that functions to generate a new license file at a software registration server which is then transmitted to a user's CPU and replaces an old license file (col. 3 lines 57-62, col. 4 lines 60-65).

For the foregoing reasons, Applicant respectfully submits that claims 1-4, 6 and 7 are allowable over Park. Applicant respectfully requests that the Examiner withdraw the rejection of claims 1-4, 6 and 7 as being unpatentable over Park under 35 U.S.C. § 103(a).

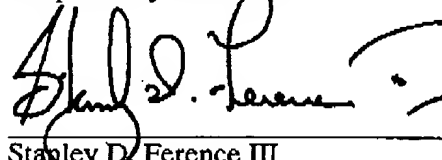
The "prior art made of record" has been reviewed. Applicants acknowledge that such prior art was not deemed by the Office to be sufficiently relevant to have been applied against the claims of the instant application. To the extent that the Office may apply such prior art against the claims in the future, Applicants will be fully prepared to respond thereto.

In view of the foregoing, it is respectfully submitted that independent claims 1-4, 6 and 7 fully distinguish over the applied art and are thus in condition for allowance.

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In summary, it is respectfully submitted that the instant application, including claims 1-4, 6 and 7, is presently in condition for allowance. Notice to the effect is hereby earnestly solicited. If there are any further issues in this application, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,



Stanley D. Ference III
Registration No. 33,879

Customer No. 35195
FERENCE & ASSOCIATES
409 Broad Street
Pittsburgh, Pennsylvania 15143
(412) 741-8400
(412) 741-9292 - Facsimile

Attorneys for Applicant